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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/325,910	06/04/1999	KEITH E. MOORE	10990146-1	3440

22879 7590 03/09/2004

HEWLETT PACKARD COMPANY  
P O BOX 272400, 3404 E. HARMONY ROAD  
INTELLECTUAL PROPERTY ADMINISTRATION  
FORT COLLINS, CO 80527-2400

EXAMINER

SINGH, RACHNA

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 03/09/2004

13

Please find below and/or attached an Office communication concerning this application or proceeding.

3

# Office Action Summary

Application No.

09/325,910

Applicant(s)

MOORE, KEITH E.

Examiner

Rachna Singh

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-20 is/are allowed.
- 6) ☒ Claim(s) 1-9, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is responsive to communications: amendment filed 12/18/03
2. Claims 1-20 are pending in the case. Claims 1, 7, and 13 are independent claims.

### ***Allowable Subject Matter***

3. Claims 13-20 are allowed.

### ***Claim Objections***

4. Claims 10-12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-5, 7-8, and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cass, US Patent 5,692,073, 11/25/97.

In reference to claim 1, Cass teaches a method in which a processor is provided with first and second document images where the first image represents an instance of a reference document to which instance a mark has been added. See column 1, lines 37-67 through column 4, lines 1-17. Cass's method comprises the following:

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-A reference document that has an associated set of active elements. The active elements are associated with at least one action. The active elements in the document is obtained and made available to the processor. The reference document serves as the original document image without the mark. See columns 1-2. Compare to ***“storing a first communication as data in a database, the storing utilizing software configured to save an identifier code associated with the first communication data in the database; associating at least a portion of the first communication together with the identifier code on a substrate.”***

-Storing a first document image comprising digital image data in a database. See column 1-2. The first image represents an instance of a reference document to which a mark has been added. Compare to ***“changing the first communication on the substrate to form a second communication which is different from the first communication.”***

-Scanning a hardcopy instance of the first document to produce an instance of a reference hypertext document to which instance a mark has been added. Interpreting any active elements indicated in the document. See columns 3-4 and abstract. Compare to ***“scanning the second communication and the identifier code with a scanning machine to digitize the second communication and the identifier code.”***

-Storing the marked document in a database. See column 8, lines 20-53.

-Providing the processor with a set of active elements for the reference (unmarked) document and extracting from the marked image a set of pixels representing the mark. The processor interprets the extracted set of pixels representing the mark by

determining whether the mark indicates any of the active elements of the reference document. Performing a reference-based mark extraction technique in which the unmarked document serves as a reference image and in which substantially the entirety of the marked document image is compared with substantially the entirety of the unmarked document does this. See column 3-4. Compare to ***“extracting information from the digitized identifier code with a processor . . . comparing the digitized second communication with the data of the first communication to identify differences between the second communication and the first communication”***.

Cass's system utilizes active elements within the reference (unmarked) document as a way of identifying if a mark on the other document. Cass teaches that typically paper-based systems utilize an identification number that uniquely corresponds to a particular type of form being used or specially coded information, such as a pattern of data glyphs or a bar code, included in the form is transmitted with the image. The computer can be programmed to seek coded information at the location within the received image and use the coded information together with additional information to identify what kind of form has been sent and to determine what is to be done in response to the boxes checked by the user. Cass goes on to teach a new approach of using active elements to identify specially coded information that is unlimited in appearance and layout of forms they support. Cass teaches using an identifier in the form of an active element to describe different portions of the document thus it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize identifier codes as suggested by Cass.

In reference to claim 2, Cass teaches making a mark on the reference document to form a second marked document. See columns 3-4. See figures 10-12 of Cass in which he displays the original document, the marked document, and removing the original document to only display the marks.

In reference to claim 3, Cass teaches producing a difference document in which the differences between the reference document and the marked document are outputted. See column 13, lines 65-67 and column 14 lines 1-7. See also figures 10-12.

In reference to claim 4, Cass teaches producing a difference document in which the differences between the reference document and the marked document are outputted. See column 13, lines 65-67 and column 14 lines 1-7. See also figures 10-12.

In reference to claim 5, Cass teaches using a scanner to digitize the document and send it to the processor. While Cass does not explicitly state using a hand-held scanner, it was well known in the art at the time of the invention to utilize hand-held scanners as a means for digitizing documents. See column 7, lines 61-67 and column 8, lines 1-11.

In reference to claim 7, Cass teaches storing multiple document instances in a database. See column 8. Each image has a marked document instance which consists of references to active elements. Similar documents are indexed together. Cass further teaches that if the document is coded with a machine-readable code such as a data glyph or barcode, the machine-readable code can be used as the index of the

document. See column 11, lines 20-26. Compare to ***“providing a database having multiple versions . . .having different version specific codes”***.

Cass teaches that an image of a marked document can be produced in a hardcopy document. The document can be coded with a machine-readable code such as a barcode that is used to index the document. See column 8, lines 20-29 and column 11, lines 20-26. Compare to ***“forming a hard copy. . .having the version specific code provided thereon in machine-readable format.”***

Cass further teaches that the machine-readable code is used to retrieve the appropriate reference document from the collection of documents given a marked document instance. The machine-readable format is read using a code-reading machine such as a scanner or fax machine. He teaches providing the processor with a set of active elements for the reference (unmarked) document and extracting from the marked image a set of pixels representing the mark. The processor interprets the extracted set of pixels representing the mark by determining whether the mark indicates any of the active elements of the reference document. Performing a reference-based mark extraction technique in which the unmarked document serves as a reference image and in which substantially the entirety of the marked document image is compared with substantially the entirety of the unmarked document does this. See column 3-4. Compare to ***“reading the machine-readable format. . .providing the document specific code and version specific code. . .wherein the second version is different than the first version.”***

Cass's system utilizes active elements within the reference (unmarked) document as a way of identifying if a mark on the other document. Cass teaches that typically paper-based systems utilize an identification number that uniquely corresponds to a particular type of form being used or specially coded information, such as a pattern of data glyphs or a bar code, included in the form is transmitted with the image. The computer can be programmed to seek coded information at the location within the received image and use the coded information together with additional information to identify what kind of form has been sent and to determine what is to be done in response to the boxes checked by the user. Cass goes on to teach a new approach of using active elements to identify specially coded information that is unlimited in appearance and layout of forms they support. Cass teaches using an identifier in the form of an active element to describe different portions of the document thus it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize identifier codes as suggested by Cass.

In reference to claim 8, Cass teaches producing a difference document that shows the differences between the two versions of the document. See figures 10-12.

In reference to claims 21-22, Cass teaches storing a marked document instance. Specifically Cass states, "once the image of the marked document instance has been stored in memory . . . the image is used to generate an index into a stored collection of documents from which an image of the corresponding stored reference document is retrieved . . ." Thus Cass does teach storing a document instance in the database. See



column 8, lines 20+. Cass also teaches assigning bar codes or machine-readable code to the documents in the stored collection. See column 11, lines 15-25.

7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cass, US Patent 5,692,073, 11/25/97 in view of Belucci et al., US Patent 5,913,542, 6/22/99 and Outwater et al., US Patent 6,203,069, 3/20/01.

In reference to claim 6, Cass does not teach having a pattern which is either camouflaged or invisible to users for the identifier code; however, Belucci discloses a system in which the identification indicia are camouflaged. See figure 1B. Furthermore, Outwater discloses a system in which the label has an invisible bar code that is invisible under certain light. See abstract. Since such features for data protection was well known and the art and it was common at the time of the invention to utilize such protection when using identifiers, it would have been obvious to incorporate these features in the system of Cass.

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cass, US Patent 5,692,073, 11/25/97 in view of Edens et al., US Patent 6,249,716, 6/19/01.

In reference to claim 9, Edens teaches a system for printing and finishing documents. Specifying the finishing and printing operations for a hard copy document is well known in the art of book printing. See columns 1-3. Since it was common to utilize such features in document processing, it would have been obvious to implement these features in the system of Cass that produces hard copy documents.

***Response to Arguments***

9. Applicant argues that Cass fails to disclose storage of a "document instance" or marked document within a database. Examiner respectfully disagrees. In column 8, lines 20+, Cass teaches storing a marked document instance. Cass states that an image of the document instance or other rendering of a known document version can be stored in a database or other collection of documents present somewhere in the system. See column 8 and rejections above. Thus Cass stores the marked document instance as a means for making available to the processor, information about active elements and information used to generate an index into the stored collection of documents.

In reference to claim 2, Applicant argues that Cass does not teach removal of a portion of the substrate having the portion of the first communication. Examiner disagrees. As stated previously with respect to claims 10-12, Cass does teach removing a portion of the substrate using a scanner. See column 3, lines 60-67 which cites, "a scanning device scans a hardcopy instance of a first document to produce a first document image. The hardcopy instance is an instance of a document to which a mark has been added". Thus Cass does teach scanning the second communication.

In reference to claim 3, Applicant argues that figures 10-12 are internally performed and not outputted. In column 13, Cass teaches that the views in figures 10-12 show test results produced by reference-based mark extraction software. Examiner maintains that Cass suggests displaying the difference document as indicated in the "test views" in figures 10-12 and columns 13-14.

In reference to claim 7, Applicant argues that Cass fails to disclose storage of a "document instance" or marked document within a database. Examiner respectfully disagrees. In column 8, lines 20+, Cass teaches storing a marked document instance. Cass states that an image of the document instance or other rendering of a known document version can be stored in a database or other collection of documents present somewhere in the system. See column 8 and rejections above. Thus Cass stores the marked document instance as a means for making available to the processor, information about active elements and information used to generate an index into the stored collection of documents. Applicant argues that Cass fails to disclose "providing a database having multiple versions of a document stored therein as data sets and the multiple versions having a common document specific code and different version specific codes". Examiner respectfully disagrees. In column 8 of his disclosure, Cass teaches that marked documents are stored into memory and are used to generate an index into a stored collection of documents. This stored collection of documents is analogous to having "multiple versions" since each marked document is a different "version" of the original. Furthermore, Cass teaches a symbolic indexing technique in which a hash code is generated to index a document. Cass further teaches that if the document is coded with a machine-readable code such as a data glyph or barcode, the machine-readable code can be used as the index of the document. See column 11. These codes serve as "version codes" and since they are used in an index, they also serve as a "common document specific code". Applicant further argues in respect to claim 7 that Cass fails to teach that a processor is configured to extract at least a

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portion of the second version. See figures 10-12 that illustrate extraction of a portion of the second version.

For reasons stated above and rejections above, Examiner maintains position with respect to claims 1-9 and 21-22.

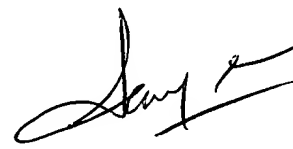
***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachna Singh whose telephone number is 703.305.1952. The examiner can normally be reached on M-F (8:30-5).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on 703.305.9792. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.305.3900.

RS  
3/1/04



SANJIV SHAH  
PRIMARY EXAMINER